

Notice of Allowability

Application No.

10/056,874

Examiner

Jon D. Epperson

Applicant(s)

CORNISH, VIRGINIA W.

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/17/07.
2. ☒ The allowed claim(s) is/are 30, 31, 35-40, 57 and 58 (renumbered 1-10).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date see attached.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

/Jon D. Epperson/
Primary Examiner, AU 1639

DETAILED ACTION

Status of the Application

1. Receipt is acknowledged of a responsive amendment, which was dated on December 17, 2007.

Status of the Claims

2. Claims 30, 31, 35-40, 57 and 58 were pending. Applicants amended claims 30, 36, and 38. No claims were added or canceled. Therefore, claims 30, 31, 35-40, 57, and 58 are pending and examined on the merits. Please note that all previous species elections have been withdrawn in view of the fact that the art search was extended to all species and no prior art was found that anticipates or renders obvious the instant claims in accordance with MPEP § 803.02. In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

IDS

3. The information disclosure statement filed 12/17/07 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent

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application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered. Please note that Applicants' purported 1449 form (referred to as Exhibit A in the 12/17/07 response) has not been received by the office.

Withdrawn Rejections

4. The 35 U.S.C. § 112, second paragraph rejection denoted "F" is withdrawn in view of Applicants' amendments to claim 36. The provisional double patenting rejection over U.S. Patent Application No. 10/705,644 is withdrawn in view of the fact that it is the only remaining rejection. See MPEP § 822.01. The 35 U.S.C. § 112, second paragraph rejection denoted "A" is withdrawn in view of Applicants' amendments to claims 30 and 38 adding steps (d) and (e). The 35 U.S.C. § 112, second paragraph rejection denoted "B" is withdrawn in view of Applicants' amendment to claim 30 adding the "to be identified" limitation. The "Enablement" rejection under 35 U.S.C. § 112, first paragraph is withdrawn in view of Applicants' amendments to claims 30 and 38 adding steps (d) and (e). The "new matter" rejection denoted "A" is withdrawn in view of Applicants' amendments to claims 30 and 38. The 35 U.S.C. § 112, first paragraph rejection denoted "B" is withdrawn in view of Applicants' arguments (e.g., see 12/17/07 Response, pages 9 and 10).

Reasons for Allowance

5. The following is the Examiner's statement of reasons for allowance:

The claims are allowed for the reasons that the prior art of record does not teach or fairly suggest the claimed method. The closest prior art is Lin et al. (e.g., see 6/2/06 Non-final, page 17-20). Although Lin et al. teach a three hybrid system like the one presently claimed, Lin et al. fail to teach the use of a second fusion protein that comprises a "penicillin-binding-protein" or a "thymidine synthase" enzyme, which enhance the cut-off K_d of the entire three-hybrid system via the formation of a covalent linkage. Thus, claims 30, 31, 35-40, 57, and 58 (renumbered 1-10) are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Salutation

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on (571) 272-0763. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Jon D. Epperson/

Primary Examiner, AU 1639